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Signature

Suzanne Marx

Typed or printed

name Suzanne MarxApplication Number
09/780,962Filed
February 9, 2001First Named Inventor
Erik James ReedArt Unit
2154Examiner
Mohammad A. Siddiqi

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

- ☒ attorney or agent of record.
Registration number 39,000

- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Carole A. Quinn
SignatureCarole A. Quinn
Typed or printed name(714) 708-6500
Telephone numberJanuary 20, 2006
DateNOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

- ☒ *Total of three forms are submitted.

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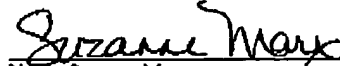
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JAN 20 2006

PATENT**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE****Application No.** 09/780,962**Group Art Unit:** 2154**Applicant(s):** Erik James Reed**Examiner:** Mohammad A. Siddiqi**Filing Date:** February 9, 2001**Docket No.** 85804-019800**Title: SYSTEM AND METHOD FOR
DETECTING AND VERIFYING
DIGITIZED CONTENT OVER A
COMPUTER NETWORK****Customer No.** 32361**CERTIFICATE UNDER 37 CFR 1.6(d)**

I hereby certify that this correspondence and identified enclosures are being transmitted via facsimile only to Examiner Siddiqi, Art Unit 2154, Facsimile No. (571) 273-8300 on January 20, 2006.


Name: Suzanne Marx**LETTER SUBMITTING REMARKS WITH
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is being filed with a Request For Pre-Appeal Brief Review and a Notice of Appeal.

REMARKS

Applicant seeks formal review by a panel of examiners of the claim rejections raised in an Office Action mailed on October 20, 2005 (hereinafter referred to as the "Office Action"). By the Office Action, at least one claim stands twice rejected. Accordingly, appeal of the rejection, and request for pre-appeal brief review, are timely and proper. More particularly, Applicant requests review of the 35 U.S.C. § 112, second paragraph and § 103(a) claim rejections. The remarks made herein supplement the remarks presented in Applicant's Preliminary Amendment, which was filed with a Request For Continued Examination on July 26, 2005.

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By the Office Action, Claims 1 to 36 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,611,812 (Hurtado) and U.S. Patent No. 6,405,203 (Collart). In addition, Claims 1, 23, 25, 27 and 29 are rejected under 35 U.S.C. § 112, second paragraph.

On January 18 and 19, 2006, telephone interviews were held between Applicant's undersigned representative and Examiner Siddiqi. During the interviews, the 35 U.S.C. § 112 second paragraph and the 35 U.S.C. § 103 rejections were discussed.

Turning first to § 103(a) rejection of the claims, during the January 18, 2006 interview, Applicant's undersigned representative pointed out that the Office Action failed to identify any portion of the applied art that discloses the feature of a songprint "derived from digitized content" as explicitly recited by the claims of the present Application. The Examiner contended that Hurtado disclosed this feature. When Applicant's undersigned representative requested that the Examiner provide an indication of which portion of Hurtado he was relying on as disclosing this feature, it was decided to postpone further discussion until January 19, 2006 in order to give the Examiner time to review Hurtado.

On January 19, 2006 and after reviewing the Hurtado reference, the Examiner agreed that Hurtado failed to disclose a content identifier, or any other identifier, derived from digitized content. The Examiner further indicated that Collart was not being relied upon for this feature. Nonetheless, and it is respectfully submitted inexplicably, the Examiner declined to agree that the rejection should be withdrawn. Rather, the Examiner indicated that he was giving the description provided in Hurtado a "broad interpretation", such that he considered Hurtado's Content ID to correspond to the claimed songprint identifier, despite the Examiner's clear (and correct) statements that Hurtado fails to disclose or even suggest an identifier, including Hurtado's Content ID, that is "derived from digitized content", as the claim so recites. Thus, the Examiner has in effect read the "derived from digitized content" limitation out of the claim, which is impermissible. It is respectfully submitted that it is improper, and clear error, to interpret a reference to include a feature which is neither taught nor suggested by the reference. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-313 (Fed. Cir. 1983).

Since the applied references do not contain any teaching or suggestion of a songprint identifier, or any other identifier for that matter, derived from digitized content, the 35 U.S.C. § 103(a) rejection is clearly both legally and factually deficient, and should be withdrawn.

The Office Action's application of Collart as disclosing a server receiving table of contents information was also discussed during the interview. More particularly, the Office

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Action cites portions of Collart, i.e., steps 600 to 650 of Figure 6 and element 560 of Figure 5, in support, and contends that this portion of Collart teaches this feature. However and as described commencing at col. 20, line 37 of Collart, the steps shown in Figure 6 are of a method for redirecting a client computer to a website in order to conduct an electronic commerce transaction in response to the client selection of a purchase option. While step 620 of Figure 6 indicates that user information is passed to a server, as described at col. 19, lines 40 to 56 of Collart, this information consists of a BCA number and a user identifier. Nothing in Collart discloses or suggests that either a BCA number or a user identifier is "table of contents information" as claimed. In any event, the deficiencies of Hurtado are sufficient to vitiate the §103 rejection, since even were the proposed combination proper it would not yield all of the claimed limitations.

Accordingly and in view of the statements made by the Examiner during the interview, as well as Applicant's remarks presented herein, it is clear that the applied art, either alone or in any hypothetical combination, fails to disclose or even to suggest each and every one of the elements of the claims. Accordingly and since the rejection under 35 U.S.C. § 103(a) is clearly deficient, reconsideration and withdrawal of the 35 U.S.C. § 103(a) are respectfully requested.

It is further submitted that the 35 U.S.C. § 112, second paragraph rejection of the claims should be withdrawn as well. As Applicant's undersigned representative pointed out during the interview, breadth of a claim is not to be equated with indefiniteness. See MPEP § 2173.04. The Office Action does not assert that there is any ambiguity as to the scope of the subject matter embraced by the claims, and indeed there is none.

Rather, the Office Action contends as the ground for rejecting the claims under § 112, second paragraph that there is no "connectivity" between the verification database and the network server recited in the claims. As Applicant's undersigned representative pointed out during the interview, with reference to Claim 1, a network server is recited which comprises the verification database. Accordingly, there is a clear connection between a verification database and a network server.

Finally, the Office Action cites MPEP § 2172.01, and contends that Claims 1, 23, 25, 27 and 29 are "incomplete" for failing to recite an essential element, which the Office Action states is "how the table of contents information is received at the server". However, as pointed out during the interview, MPEP § 2172.01 states that in order for an element to be an essential element, the element must be disclosed to be essential to the invention as described in the

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specification or in other statements of record. The Office Action fails to cite to anything in the record to support the position taken in the Office Action that the element is essential to the invention. Accordingly, it is submitted that there is no factual or legal basis shown for a rejection under 35 U.S.C. § 112, second paragraph. Reconsideration and withdrawal of the 35 U.S.C. § 112, second paragraph rejection are therefore respectfully requested.

Accordingly, based on the remarks made herein, together with the remarks presented in Applicant's Preliminary Amendment filed on July 26, 2005, it is submitted that the legal requirements under 35 U.S.C. §§ 103 and 112, second paragraph have not been met. Reconsideration and withdrawal of the 35 U.S.C. §§ 103 and 112, second paragraph rejections are therefore respectfully requested.

No additional fee is believed to be necessary. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-2638. Please ensure that the Attorney Docket Number is referenced when charging payments or credits for this case.

Respectfully submitted,

Date: January 20, 2006


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